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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91213825
Party	Plaintiff Paramount Farms International LLC
Correspondence Address	Paramount Farms International LLC 11444 W. Olympic Blvd. Los Angeles, CA 90064 UNITED STATES mvasseghi@roll.com, mrivera@roll.com, jreider@roll.com, jhenry@roll.com
Submission	Other Motions/Papers
Filer's Name	Michael M. Vasseghi
Filer's e-mail	mvasseghi@roll.com, jreider@roll.com, jhenry@roll.com, mrivera@roll.com
Signature	/s/ Michael M. Vasseghi /s/
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Attachments	Oppo. to Motion to Dismiss.pdf(17432 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Paramount Farms International LLC	)	
	)	
	)	Opposition No.: 91213825
Opposer,	)	
	)	
v.	)	
	)	
Wonderfully Raw Gourmet Delights, LLC	)	
	)	Mark: WONDERFULLY RAW
Applicant.	)	Application Ser. No.: 85898315
	)	
	)	
	)	

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**OPPOSER’S OPPOSITION TO MOTION TO DISMISS**

In response to the Motion to Dismiss (hereinafter the “Motion”) filed by WONDERFULLY RAW (hereinafter “Applicant”), PARAMOUNT FARMS INTERNATIONAL LLC (hereinafter “Opposer”) submits its Opposition to the Applicant’s Motion to Dismiss. Opposer alleges herein that the Notice of Opposition (the “Opposition”), as filed, pleaded facts so as to state claims upon which relief may be granted. Applicant’s Motion to Dismiss overlooks significant elements of Opposer’s pleading and also misstates well founded relevant precedent.

**Factual Background**

Opposer has extensively marketed and sold processed and natural nuts in interstate commerce in connection with its distinctive and famous WONDERFUL marks, and other marks comprised of the distinctive element WONDERFUL (collectively the “WONDERFUL Marks”). Opposer has sold millions of dollars worth of goods in connection with the WONDERFUL Marks.

Opposer's registrations include, but are not limited to, WONDERFUL, Reg. No. 3,443,097; WONDERFUL PISTACHIOS, Reg. No. 3,463,342; WONDERFUL and DESIGN, Reg. Nos. 3,784,763; 3,907,814; 3,907,815; WONDERFUL ALMONDS, Reg. No. 4,307,930; WONDERFUL MINIALMONDS, Reg. No. 3,984,224; WONDERFUL MINIALMONDS and DESIGN, Reg. No. 4307923.

Opposer filed a Notice of Opposition seeking cancellation of the registration for the WONDERFULLY RAW Mark (hereinafter "Applicant's Mark") filed by Applicant, Application Ser. No.: 85898315 (hereinafter "Opposer's Mark").

### **Argument**

#### **Opposer's Notice of Opposition Should Withstand a Motion to Dismiss**

To survive a motion to dismiss under Rule 12(b)(6), a notice of opposition need only allege such facts as would, if proved, establish that opposer is entitled to the relief sought, that is, that (1) opposer has standing to challenge the application, and (2) a valid ground exists for seeking to oppose registration. *Compangnie Gervais DAnone v. Precision Formulations, LLC*, 89 U.S.P.Q.2d 1251 (TTAB 2009). Further, in the context of a Rule 12(b)(6) motion to dismiss, all well-pleaded allegations must be accepted as true, and must be construed in the light most favorable to opposer. *See Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 U.S.P.Q.2d 1038 (Fed. Cir. 1993). The pleading should include enough detail to give the defendant fair notice of the basis for each claim. *See McDonnell Douglas Corp. v. National Data Corp.*, 228 U.S.P.Q. 45 (TTAB 1985).

Applicant's Motion does not question Opposer's standing to challenge the application. Nor does Applicant argue that there is no valid grounds for the opposition. Rather, Applicant contends that it "believes" that its amendments to its registration, along with the absence of

overlapping channels of trade eliminate any ground for likelihood of confusion. [Motion p. 2]. First, Applicant's *belief* as to whether there is a likelihood of confusion is completely irrelevant. Second, Applicant cannot simply make unsubstantiated arguments, with any evidence in support of a Motion to Dismiss. It is unclear why Applicant incorrectly contends that there are no overlapping channels of trade, or that there are no overlapping goods. [Motion p.2] Such questions of fact will be examined during the course of discovery, and are immaterial at the Motion to Dismiss stage. Since well pleaded allegations must be accepted as true, the Board need only consider the Notice of Opposition which properly asserts: "Applicant's Goods are identical, similar and/or related to the goods used in connection with the WONDERFUL Marks." [Notice of Opposition ¶ 15]

Applicant's argument that its amended registration somehow invalidates Opposer's Notice of Opposition also misses the mark. In a misguided effort to distinguish itself from Opposer's registrations, Applicant revised its registration to "excludes nuts, except as ingredient". However, the amendment gives no credence to Applicant's Motion. The products for the underlying marks still overlap since both contain nuts, both are sold as snacks and both marks are registered in the same class – all of which support a likelihood of confusion finding.

Applicant also challenges Opposer's dilution claim on the grounds that "Opposer has not sufficiently pled any allegation of distinctiveness that meets the threshold for a dilution claim." [Motion p. 3] Applicant is incorrect. The Notice of Opposition provides that "prior to Applicant's claimed first use date, the WONDERFUL Marks became distinctive and famous in accordance with 15 U.S.C. 1125 (c)." [Notice of Opp. ¶ 19] That is all Opposer needs to allege to provide "defendant fair notice of the basis for each claim." *See McDonnell Douglas Corp. v.*

*National Data Corp. supra.* Moreover, even though not required, Opposer provided some level of detail as to why it has become famous, including its amount of sales [¶ 4]; its amount of advertising [¶ 5]; and the scope of its advertising [¶ 6] all of which are factors relevant to a finding of both fame and distinctiveness. *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2d 1164 (TTAB 2001) citing to 15 U.S.C. § 1125(c)(1).

Finally Applicant argues that a dilution claim requires that the mark “be identical or very or substantially similar.” [Motion p. 3]. First such an inquiry is a question of fact and not suitable for determination of a Motion to Dismiss. Second, there are four elements which must be pled for a claim of dilution – none involves a comparison of the marks as Applicant suggests. Those four factors are: (1) the other party’s use is in commerce; (2) the other party adopted its mark after the plaintiff’s mark became famous; (3) the mark is famous; and (4) the other party diluted the mark. *Toro Co. supra.*

### **Conclusion**

Opposer has standing to oppose Applicant’s Registration and the Notice of Opposition avers acceptable bases for an opposition. Opposer has pleaded sufficient facts for both likelihood of confusion and dilution. Applicant’s Motion ignores the factual bases for Opposer’s claims. Applicant’s Motion should be denied.

### **Opposer’s Request to Reserve Right to Amend Pleadings**

Opposer requests that, should the Board find that the Notice of Opposition fails to state a claim upon which relief can be granted, the Board will grant Opposer time to file an amended pleading. Pursuant to Section 507.02 of the TBMP and Section 15(a) of the Federal Rules of Civil Procedure, the Board may freely grant permission to amend a pleading where justice so requires.

Based on the foregoing, Opposer respectfully requests that the Board deny Applicant's Motion to Dismiss.

Date: January 22, 2014

Paramount Farms International LLC

By: /s/ Michael M. Vasseghi /s/  
Michael M. Vasseghi, Esq.  
ROLL LAW GROUP P.C.  
11444 West Olympic Blvd.  
Los Angeles, California 90064  
Tel. (310) 966-8776  
Fax (310) 966-8100  
*Attorney for Opposer*

**CERTIFICATE OF SERVICE**

I, Janice Henry, hereby certify that a copy of this OPPOSER'S OPPOSITION TO MOTION TO DISMISS has been served upon Applicant at the correspondence address of record:

Wendy Peterson  
Not Just Patents  
P.O. Box 18716  
Minneapolis, MN 55418

via e-mail and U.S. Mail on this 22nd day of January, 2014.

By: /s/ Janice Henry /s/  
Roll Law Group P.C.  
11444 West Olympic Blvd.  
Los Angeles, CA 90064  
Tel. (310) 966-8400  
Fax (310) 966-8810